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LADAS & PARRY LLP 26 WEST 61ST STREET NEW YORK, NY 10023			UTAMA, ROBERT J	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/582,186	Applicant(s) PALACIOS ORUETA, ANGEL	
	Examiner ROBERT J. UTAMA	Art Unit 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/08/2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1, the phrase "for example" and "can be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. Claims 4-6, 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, 9 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention and also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In order to employ mean plus function language in a claim, one must set forth in the specification an adequate disclosure showing adequate structure (or material or acts) for performing the recited functions (see MPEP 2181 part II). In this particular case, the specification as originally filed failed to provide the structure and mean to perform the function of identifying and selecting the minimal chosen phrase (claim 4), collapsing or expanding chosen phrase (claim 5) and means for replacing words (claim 11).

5. Claims 41-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. Claims 41-46 are rejected since it is unclear which of the statutory class "a data collection" or "a computer program" is directed toward.

6. Claims 3-7, 12, 15-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 4-5 are directed toward a minimal chosen phrase. However, the specification does not provide enablement for one of ordinary skilled in the art to identify a minimal chosen phrase. Claim 5 are directed toward a parent of phrase. However, the specification as provided never provides enablement for identifying a parent of a chose phrase. Claim 15-19 are directed toward an escalator tree. However, the specification as originally provided fails to provide enablement support for one of ordinary skilled in the art to construct or use an escalator tree.

Drawings

7. The drawings are objected to because the drawing illustrations are not in English. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant

will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 22-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A process claimed is considered to be directed to a statutory subject matter if it can be shown that the claimed process:

- be tied to a particular machine or apparatus (machine implemented); or
- transforms a particular article to a different state or thing.

Additionally, the particular machine tie or particular transformation must meet two corollaries to pass the test for subject matter eligibility. First, the use of the particular machine or transformation of the particular article must impose a **meaningful limit** on the claim's scope. So, a machine tie in only a field-of-use limitation would not be sufficient. Second, the use of the particular machine or the transformation of the particular article must involve **more than insignificant "extra-solution" activity**. In this particular case,

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claims 22—40 are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. § 101. The rationale for this finding is explained below:

- Insufficient recitation of a machine or transformation.
- Involvement of machine, or transformation, with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied.

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- Machine is generically recited such that it covers any machine capable of performing the claimed step(s).
- Machine is merely an object on which the method operates.

Claims 41-42 are rejected since it is unclear which of the statutory class "A data collection" is directed toward. A claim is considered statutory if it is directed toward a process, a machine, an article of manufacture or a composition of matter. Claims 43-46 are rejected since it is directed towards a computer program that is not embodied in a computer readable medium.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-14 and 21-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Sameth US 5,697,789**

Claims 1 and 22 : The Sameth reference provides a teaching of system for facilitating the comprehension of a target language (see Abstract) wherein the target language can be a foreign language (see abstract "include phrases in foreign language) and where the target language can be oral (see col. 2:20-35 "lip guide") and said system is applied to one samples of such target language (see FIG. 4A) and said system comprises mean to provide one ore more perspective over the structure of one or more fragments of said target language samples which can facilitates the user learner comprehends the structure and meaning of said fragments (see col. 4:45-50) and wherein said perspective can be created on a computer screen under the control of a program (see col. 5:35-50).

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Claim 2: The Sameth reference provides a teaching wherein said hardware mean can exist in one single platform (see paragraph 3 line 60 "multimedia computer 52").

Claim 3 and 23: The Sameth reference provides a teaching where in said structure said fragments are defined over a number of groups of words that compose said fragments and wherein said groups of words will generally be phrases (see col. 4:45 "a phrase in foreign language... "). While the Sameth reference do not called the phrase a chosen phrases, the examiner do not attach any patentable weight on the naming convention of a phrase. Since, the naming convention of a phrase do not

Claims 4 and 24: The Sameth reference provides a teaching of means of identifying and selecting the minimal chosen phrase of a position where the minimal chosen phrase of a position is the chosen phrase that covers that position and that does not contain any other chose phrase that covers that position (see col. 2:15-25).

Claims 5 and 25: The Sameth reference provides a teaching of one of said perspective comprises means to identify and select the chose phrase that is parent of the chosen phrase that is selected at a given moment (see col. 4:35-55).

Claims 6 and 26: The Sameth reference provides a teaching of comprising means for collapsing or expanding chosen phrases, where said collapsing produces the effect that the collapsed phrase has a different representation in some of said perspectives, and said expanding produces the effect that the chosen phrase has a normal representation in said perspectives, where the representation of said chosen phrases depends on the nature of each of said perspectives (see col. 7:50-60).

Claims 7 and 27: The Sameth reference provides a teaching that it is possible to enable and disable different types of phrases, where such disabling produces the effect that said chosen phrases that are disabled do not appear as phrases in said perspectives (see col. 8:20-25).

Claims 8 and 28: The Sameth reference provides a teaching of means for assigning, in at least one of said perspectives, one or more replacing words to different groups of words of said

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fragments, so it will be possible to represent said fragments in said perspectives in such a way that said replacing words will be in the place of those groups of words to which they are assigned (see col.).

Claims 9 and 29: The Sameth reference provides a teaching of wherein there exist different types of replacing words for different types of groups of words, so that, for example, the groups of words that correspond to relative clauses might have a type of replacing word and the groups of words that are clauses of other type might have other type of replacing word (see FIG 7 item 126).

Claims 10 and 30: The Sameth reference provides a teaching of said replacing words are words that do not exist in the target language, and where in they have been assigned an alphanumeric index such as for example "XYZ1" o "ABCD#1 (see FIG 7 item 126 having both Japanese character and English character).

Claims 11 and 31: The Sameth reference provides a teaching of comprising means for replacing said replacing words by the groups of words to which they are assigned, in at least one of said perspectives and in a fragment in which they appears (see col. 6:40-45).

Claims 12 and 32: The Sameth reference provides a teaching of one or more of said chosen phrases, said system comprises one or more clarifications that provide information about said chosen phrases, where said clarifications can be shown in different fashion in said perspectives (see col. 6:30-35).

Claims 13 and 33: The Sameth reference provides a teaching of clarification 3 for clause phrases, where said clarification 3 is the same character string as said phrase except for the fact that it has been modified to convert it into a sentence that has the normal order of the target language (see col. 7:25-35).

Claims 14 and 34: The Sameth reference provides a teaching of a clarification 4 for those clause phrases whose main verb is not in indicative mode, where such clarification 4 is the

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same character string as said phrase, or as its clarification 3 if it exists, except for the fact that the main verb has been replace by the infinitive form of said main verb (see col. 6:40-50).

Claims 21 and 40: The Sameth reference provides a teaching where said perspective in audiovisual perspective, which is characterized because it aurally play back a portion that has been chosen on said fragment, wherein emphasis has been applied on some parts of it have been chosen by the user (see col. 6:55-65).

Claims 41-46: The Sameth reference provides a teaching of a data collection and computer program that implement the system of claim 1, 22, 41 and 44 (see col. 5:20-25).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 15-20 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sameth US 5,697,789 in view of Walker US 7,036,075.**

Claims 15 and 35: The Sameth reference fail to provide one of said perspective shows escalator tree is the arrangment of said text fragments in different rows. The Walker reference provides a teaching of one of said perspective shows escalator tree is the arrangment of said text fragments in different rows (see col. 7:15-25 and FIG 2). Both the Sameth and Walker references disclose a language learning computer based training program. One of ordinary skilled in the art would have considered both teaching of Sameth and Walker reference to be relevant and analogous art. Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of one of said perspective shows escalator tree is the arrangement

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of said text fragments in different rows, as taught by Walker, in order to break up the sentence into more manageable phrases (see col. 10:20-25).

Claims 16: The Sameth reference fails to provide a teaching of escalator tree is built by using text controls that represents the same text fragment, so that they give the impression that said groups of words do not exist. However, the Walker reference escalator tree is built by using text controls that represents the same text fragment, so that they give the impression that said groups of words do not exist (see FIG 11 item 200, 202, and 203). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of escalator tree is built by using text controls that represents the same text fragment, so that they give the impression that said groups of words do or do not exist, as taught by Walker, in order to break up the sentence into more manageable phrases (see col. 10:20-25).

Claims 17 and 36: The Sameth fails to provide a teaching where different levels of different words are assigned independently from the embedding level of said words in the phrase tree of the text of to which they belong. However, the Walker reference provides a teaching of different levels of different words are assigned independently from the embedding level of said words in the phrase tree of the text of to which they belong (see col. 15:35-50).

Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of different levels of different words are assigned independently from the embedding level of said words in the phrase tree of the text of to which they belong, as taught by Walker, in order to break up the sentence into more manageable phrases (see col. 10:20-25).

Claims 18 and 37: The Sameth fails to provide a teaching wherein the levels of the words in the

escalator tree are codified by the utilization of special delimiter characters in said text fragment, so that some characters indicate a change of level, and others do not indicate a change of level, where there might be different types of delimiter characters if it necessary to indicate level changes that have different magnitudes. The Walker reference provides a

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teaching of wherein the levels of the words in the escalator tree are codified by the utilization of special delimiter characters in said text fragment, so that some characters indicate a change of level, and others do not indicate a change of level, where there might be different types of delimiter characters if it necessary to indicate level changes that have different magnitudes (see col. 15:35-50). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of wherein the levels of the words in the escalator tree are codified by the utilization of special delimiter characters in said text fragment, so that some characters indicate a change of level, and others do not indicate a change of level, where there might be different types of delimiter characters if it necessary to indicate level changes that have different magnitudes, as taught by Walker, in order to break up the sentence into more manageable phrases (see col. 10:20-25).

Claims 19 and 38: The Sameth fails to provide a teaching wherein one of said perspectives shows the tower tree or the informative tree of the fragment, where said trees are an arrangement in the form of a table in which the chosen phrases are arranged vertically, and it optionally has additional cells to show additional information, such as for example the clarifications of each chosen phrase. The Walker reference provides a teaching of wherein one of said perspectives shows the tower tree or the informative tree of the fragment, where said trees are an arrangement in the form of a table in which the chosen phrases are arranged vertically, and it optionally has additional cells to show additional information, such as for example the clarifications of each chosen phrase (see col. 7:5-35). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of wherein one of said perspectives shows the tower tree or the informative tree of the fragment, where said trees are an arrangement in the form of a table in which the chosen phrases are arranged vertically, and it optionally has additional cells to show additional information, such as for example the clarifications of each chosen phrase, as taught by Walker, in order to break up the sentence into more manageable phrases (see col. 10:20-25).

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Claims 20 and 39: The Sameth fails to provide a teaching wherein one of said perspectives show the grammatical perspective of said fragment, wherein the grammatical perspective is an arrangement in table form, so that different portions of such fragment that fulfill different grammatical function occupy different cells. The walker reference provides a teaching of wherein one of said perspectives show the grammatical perspective of said fragment, wherein the grammatical perspective is an arrangement in table form, so that different portions of such fragment that fulfill different grammatical function occupy different cells (see FIG 2 column "word pos, dict"). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of one of said perspectives show the grammatical perspective of said fragment, wherein the grammatical perspective is an arrangement in table form, so that different portions of such fragment that fulfill different grammatical function occupy different cells, as taught by Walker, in order to break up the sentence into more manageable phrases (see col. 10:20-25).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. UTAMA whose telephone number is (571)272-1676. The examiner can normally be reached on 9-5:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/R. J. U./
Examiner, Art Unit 3715

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